

### REMARKS

In this office action the Examiner rejected claims 1-4, 6, 10, 13-15 and 17 under 35 U.S.C. 102(b) as being anticipated by DiOrio (US 6,357,703B1). To support the rejection the Examiner stated,

"DiOrio teaches an apparatus for securing a mouse support pad to a predetermined member, comprising:

- \* A vertical member (42, fig. 3) having a predetermined size and shaped (shown in fig. 3), and a first end (lower end of 42, fig. 3, not numbered) (claims 1 and 10)

- \* A slot (between members 44 and 46, fig. 4, not numbered) disposed within said vertical member intermediate said first end and said second end of said vertical member, having a predetermined width (shown in fig. 4) being sufficient to slide onto a desktop (18, fig. 3) (claims 1,6,10 and 17)

- \* A securement device (52, fig. 3) disposed on said first end of said vertical member to a predetermined number (18, fig. 3) (claims 1 and 10)

- \* A means (50, fig. 4; see col. 6, lines 11-13) for securing the mouse support pad (24, fig. 4) to said second end of said vertical member (claims 1 and 10)

- \* Wherein said securement device includes a bolt (52, fig. 10) being threadably attached to said first end of said vertical member and entering said slot of said vertical member (shown in fig. 3) (claims 2-4 and 13-15)

\* Wherein said mouse support pad is a solid platform made of plastic (see col. 5, lines 53-55) (claim 11)."

Applicant has amended claims 1 and 10 to include the limitation and to further clarify that the slot in the vertical member is closely adjacent the first end of the vertical member so that the vertical member extends upwardly from an upper surface of the predetermined member. There really is no vertical member in the invention of DiOrio. Thus, the present invention is clearly different from that as taught by DiOrio.

DiOrio teaches a clamp (42), which the Examiner has called a vertical member. However, as taught by DiOrio, "The clamp 42 is comprised of a generally U-shaped bracket having a first leg 44 and a second leg 46 joined by a bight portion 48. The first leg 44 is connected to a bottom surface of the upper support region 28, such as by fasteners 50 along a longitudinal axis thereof. The second leg 46 is threadably engaged with a rotatable clamping screw 52 having a grip knob 54 at the bottom end and engaging disc 56 at its top. The engaging disc 56 is preferably provided with a non-marring surface for engaging the bottom surface of the shelf 18, while the first leg 44 rests upon the top surface of the shelf 18." (Column 6, lines 9-19).

There is no teaching or even a suggestion in DiOrio of having a vertical member that extends upwardly from the predetermined member or shelf. DiOrio's teaching is directed to a hingeable wrist support for use with a mousing surface. The

apparatus of DiOrio is quite different from the apparatus as claimed in claims 1 and 10.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-4, 6, 10, 13-15 and 17 under 35 U.S.C. 102(b) as being anticipated by DiOrio (US 6,357,703B1).

Further in the office action the Examiner rejected claims 7 and 18 under 35 U.S.C. 103(a) as being unpatentable over DiOrio. The Examiner stated, "DiOrio discloses the claimed invention except specifying the means for securing the mouse support pad to the second end of the vertical member are capscrews.

However, DiOrio teaches a set of fasteners (58, fig. 5) being capscrews. It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify the fastening means (50, fig. 4) being also capscrews for clearly indicating the fasteners used."

The Examiner also rejected claims 9 and 19 under 35 U.S.C. 103(a) as being unpatentable over DiOrio. The Examiner stated,

"DiOrio discloses the claimed invention except specifying the slot being disclosed between 0.25 inches and 0.5 inches from the first end of the vertical member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify the slot being disposed between 0.25 inches and 0.5 inches from the end of the vertical member and to indicate in fig. 3, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being

within the level of ordinary skill in the art. See MPEP  
§2144.04, VI, A."


Applicant has discussed previously that independent claims 1 and 10 were amended to include the limitation and to further clarify that the slot is closely adjacent the first end of the vertical member so that the vertical member extends upwardly from an upper surface of the predetermined member. Claims 7, 9, 18 and 19 are dependent claims upon claims 1 and 10 which are clearly different from the teaching of DiOrio. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 7, 9, 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over DiOrio.

In view of the amendment to the claims and the discussion supra, it is believed that the invention as described in claims 1-19 is patentable and that this application is now in condition for allowance and such allowance by the Examiner is respectfully requested.

In the event the Examiner has further difficulties with the examination and/or allowance of the application, the Examiner is invited to contact the undersigned agent for applicant by telephone at (412) 380-0725, if necessary, to resolve any

remaining questions or issues by interview and/or Examiner's  
Amendment as to any matter.

Respectfully submitted,  
James Ray and Associates

By   
Amos Bartoli  
Registration No. 42,299  
Agent for Applicant

JAMES RAY & ASSOCIATES  
2640 Pitcairn Road  
Monroeville, PA 15146  
Tel. (412) 380-0725  
Fax (412) 380-0748